

REMARKS

Favorable reconsideration and withdrawal of the objection and rejections set forth in the above-mentioned Official Action in view of the foregoing amendments and the following remarks are respectfully requested.

Specification

The specification has been amended to place it in better form. It is respectfully submitted that no new matter has been added.

Claims Status

Claims 1 through 8 are now pending in the application. Claims 1 through 7 have been amended to even more succinctly define the invention and/or to improve their form. Claim 8 has been added to accord Applicants an additional scope of protection commensurate with the disclosure. It is respectfully submitted that no new matter has been added. Claims 1 and 7 are the only independent claims pending in the application.

Allowable Subject Matter

It is acknowledged with appreciation that Claim 7 is merely objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

In response, Claim 7 has been rewritten in independent form to generally include the features of Claims 1 and 2 while improving its form. It is respectfully submitted that the objection has been overcome and that Claim 7 and Claim 8, which depends thereon, are allowable.

Provisional Double Patenting Rejection

Claim 1 of the current application is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of copending application No. 10/687,813 (the “813 application”). This rejection is traversed.

Amended Claim 1 calls for an image forming apparatus that includes a plurality of developing devices for developing an electrostatic image formed on an image bearing member; and a rotary member holding the plurality of developing devices for selectively moving any one of the developing devices to a developing position. Each of the plurality of developing devices has a first developer carrying member and a second developer carrying member for developing the electrostatic image with developers carried thereby, respectively. Each of the plurality of developing devices is held by the rotary member so as to be relatively rockable with respect to the rotary member. When the one of the developing devices is in the developing position, the first developer carrying member and the second developer carrying member of the one of the developing devices are positioned in predetermined positions with respect to the image bearing member, respectively.

Since Claim 1 of the ‘813 application was canceled in the Amendment filed January 21, 2005, the provisional double patenting rejection is deemed moot. Moreover, there are significant differences between the pending claims of the ‘813 application and Claim 1 of the instant application such that the claims are not obvious variants of one another. For example, Claim 12 of the ‘813 application recites that the rotary member starts a deceleration of a rotational speed before a selected developing device arrives at a

developing position, and further recites first and second abutting means. At least these differences between the claims should obviate the provisional double patenting rejection.

In the event the Examiner intends to retain the provisional double patenting rejection, it is respectfully requested that the rejection be held in abeyance until the '813 application is allowed.

Art Rejections

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,258,819 (Kimura, et al.).

Claims 1 through 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,160,969 (Mizuma, et al.) in view of Japanese Patent Document No. 11-2961 (Kashiwabara).

The rationale underlying the art rejections is succinctly set forth in the Official Action.

Response to Art Rejections

The art rejections are respectfully traversed.

With the arrangement recited in Claim 1, the positioning of each developer carrying member to an image bearing member can be surely performed with a simple structure. That is, as a developing device having the first and second developer carrying members is relatively rockable with respect to a rotary member, there is no need to change positions of the respective developer carrying members in the developing device when the positioning of each developer carrying member to the image bearing member is performed. If it is required to change the positions of the respective developer carrying members in the developing device, a mechanism for moving the developer carrying members without

allowing the developer to leak out of the developing device is typically required. This leads to a significantly complicated mechanism. Furthermore, such a mechanism requires many movable parts, which leads to poor endurance.

Kimura, et al. discloses a developing rotary member 5 having a plurality of developing devices. The rotary member 5 is rockable with respect to an image bearing member or carrier 4. However, Kimura, et al. does not disclose or suggest at least a first developer carrying member and a second developer carrying member for developing the electrostatic image with developers carried thereby, respectively, and each of said plurality of developing devices is held by a rotary member so as to be relatively rockable with respect to the rotary member, as is recited in Claim 1. In Kimura, et al., a supply roller 23 supplies developer to a developing roller 22, but does not develop an electrostatic image with developer carried thereby. Each developing device of Kimura, et al. is fixed to the rotary member 5, but is not relatively rockable with respect to the rotary member.

Therefore, Kimura, et al. fails to disclose or suggest important features of the present invention recited in Claim 1.

Mizuma, et al. discloses a rotary developing member 137 having a plurality of developing devices or containers (107, 109, 111, 113) as shown in Figure 6. However, Mizuma, et al. discloses merely each developing device having one developer carrying member or roller. Therefore, Mizuma, et al. neither discloses nor suggests a problem in positioning two developer carrying members when a developing device having the two developer carrying members is rotated, and a technical solution for solving the problem. Mizuma, et al. also fails to disclose or suggest those features of the present invention noted above as being deficient in Kimura, et al.

Kashiwabara discloses a single stationary developing device or housing 10 provided with a developer carrying (application) member 30 fixed to the developing device and a developer carrying (application) member 40 movable toward an image bearing member or drum 2. However, as the developer carrying member 40 is relatively movable with respect to the developing device, Kashiwabara requires a mechanism for moving the developer carrying member without allowing developer to leak out of the developing device. This leads to a significantly complicated structure and many movable parts. As a result, the apparatus becomes poor in endurance. Kashiwabara neither discloses nor suggests that each of the plurality of developing devices is held by a rotary member so as to be relatively rockable with respect to the rotary member. Therefore, Kashiwabara fails to remedy the deficiencies of Mizuma, et al. noted above with respect to Claim 1.

It is also respectfully submitted that the combination rejection is not well-founded. The Examiner has provided a *rationalization* for combining the teachings of the cited art based on the benefits of doing so. A combination rejection is proper only when there is some suggestion or motivation in the cited art *per se* to cause one having ordinary skill in the art to combine the teachings of the cited art. There is nothing in the cited art which supports the position that it can be combined in the manner suggested. Even if the art could be so combined, the mere fact that the art can be combined is not sufficient if there is no suggestions in the art that such a combination is desirable. For example, see ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

In view of the foregoing, it is respectfully submitted that independent Claim 1 is allowable over the cited art whether taken individually or in combination.

Dependent Claims

Claims 2 through 6 and 8 depend either directly or indirectly from one of Claims 1 and 7 and are allowable by virtue of their dependency and in their own right for further defining Applicants' invention. Individual consideration of the dependent claims is respectfully requested.

Closing Comments

It is respectfully submitted that the claims on file are allowable over the art of record and that the application is in condition for allowance. Favorable reconsideration and early passage to issue of the present application are earnestly solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our New York office at the address shown below.

Respectfully submitted,



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